

Translation

PATENT COOPERATION TREATY

PCT/JP2003/015223



PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY  
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference E1-A0207P	FOR FURTHER ACTION	See Form PCT/IPEA/416
International application No. PCT/JP2003/015223	International filing date (day/month/year) 28 November 2003 (28.11.2003)	Priority date (day/month/year) 28 November 2002 (28.11.2002)
International Patent Classification (IPC) or national classification and IPC C12N 15/12, 1/15, 1/19, 1/21, 5/00, C07K 14/47, 16/18		
Applicant EISAI CO., LTD.		

1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 5 sheets, including this cover sheet.
3. This report is also accompanied by ANNEXES, comprising:
  - a. ☐ (sent to the applicant and to the International Bureau) a total of \_\_\_\_\_ sheets, as follows:
    - ☐ sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).
    - ☐ sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.
  - b. ☒ (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) Disc 1, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).

4. This report contains indications relating to the following items:

- ☒ Box No. I Basis of the report
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

Date of submission of the demand 10 February 2004 (10.02.2004)	Date of completion of this report 26 May 2004 (26.05.2004)
Name and mailing address of the IPEA/JP	Authorized officer
Facsimile No.	Telephone No.

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/JP2003/015223

## Box No. I Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.

- ☐ This report is based on translations from the original language into the following language \_\_\_\_\_, which is language of a translation furnished for the purpose of:
- ☐ international search (under Rules 12.3 and 23.1(b))
  - ☐ publication of the international application (under Rule 12.4)
  - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)

2. With regard to the elements of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:

- ☒ The international application as originally filed/furnished
- ☐ the description:
- pages \_\_\_\_\_, as originally filed/furnished
- pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- ☐ the claims:
- pages \_\_\_\_\_, as originally filed/furnished
- pages\* \_\_\_\_\_, as amended (together with any statement) under Article 19
- pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- ☐ the drawings:
- pages \_\_\_\_\_, as originally filed/furnished
- pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- ☒ a sequence listing and/or any related table(s) – see Supplemental Box Relating to Sequence Listing.

3. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, Nos. \_\_\_\_\_
- ☐ the drawings, sheets/figs \_\_\_\_\_
- ☐ the sequence listing (*specify*): \_\_\_\_\_
- ☐ any table(s) related to sequence listing (*specify*): \_\_\_\_\_

4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, Nos. \_\_\_\_\_
- ☐ the drawings, sheets/figs \_\_\_\_\_
- ☐ the sequence listing (*specify*): \_\_\_\_\_
- ☐ any table(s) related to sequence listing (*specify*): \_\_\_\_\_

\* If item 4 applies, some or all of those sheets may be marked "superseded."

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/JP03/15223

**Box No. V** Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

## 1. Statement

Novelty (N)

Claims	1-4	YES
Claims	5-7	NO

Inventive step (IS)

Claims	1-4	YES
Claims	5-7	NO

Industrial applicability (IA)

Claims	1-7	YES
Claims		NO

## 2. Citations and explanations (Rule 70.7)

Document 1: Cloning and Expression of Xenopus Prickle, an Orthologue of a *Drosophila* Planar Cell Polarity Gene, (J. B. Wallingford, et al.), Mechanisms of Development, August 2002, Vol. 116, pages 183-186

Document 2: The Balance between Isoforms of the Prickle LIM Domain Protein Is Critical for Planar Polarity in *Drosophila* Imaginal Discs, (D. Gubb, et al.), Genes & Development, 1999, Vol. 13, pages 2315-2317

## Claims 5-7

Documents 1 and 2 describe a prickles protein of *Drosophila* that is highly homologous to a mammal prickles protein, and they have a common amino acid sequence. The prickles protein, therefore, of *Drosophila* described in documents 1 and 2 has the same amino acid sequence as the polypeptide fragment of the above claims. Accordingly, the subject matters of the above claims do not appear to be novel or to involve an inventive step in view of documents 1 and 2.

## Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

## Claims 5-7

The polypeptide fragment of the above claims encompasses not only fragments having amino acid sequences specific to mammal prickly proteins but also fragments non-specific to them, e.g., those having an amino acid sequence in common with prickly proteins of *Drosophila*. For the latter fragments, it is not known whether they are used to create an antibody that specifically identifies mammal prickly proteins or for other uses, and so their usefulness is unknown.

Accordingly, the invention of polypeptide fragments of the above claims is not adequately supported by the specification, nor disclosed so clearly and adequately as to allow a person skilled in the art in the relevant technical field to reduce it to practice.

## Supplemental Box Relating to Sequence Listing

## Continuation of Box No. 1, item 2:

1. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this report was established on the basis that of:
- a. type of material
    - ☒ a sequence listing
    - ☐ table(s) related to the sequence listing
  - b. format of material
    - ☐ in written format
    - ☒ in computer readable form
  - c. time of filing/furnishing
    - ☐ contained in the international application as filed
    - ☒ filed together with the international application in computer readable form
    - ☐ furnished subsequently to this Authority for the purpose of search and/or examination
    - ☐ received by this Authority as an amendment\* on \_\_\_\_\_
2. ☒ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
3. Additional comments:

*\* If item 4 in Box No. 1 applies, the listing and /or table(s) related thereto, which form part of the basis of the report, may be marked "superseded".*